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REMARKS

Claims 18 and 32-37 remain pending in this application after entry of this amendment. Claim 18 was amended herein. Support for the amendment to claim 18 can be found at least at page 13, lines 17-19. Claims 36-37 were added herein. Support for newly added claim 36 can be found at least at page 11, lines 21-22. Support for newly added claim 37 can be found at least at page 11, lines 21-22.

Claim 18 is objected to because of informalities. Applicant respectfully traverses this rejection.

Claims 18 and 32-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Alferness (U.S. Patent No. 5,702,343). Applicant respectfully traverses this rejection.

Objection

Claim 18 is objected to because of the informality in line 4, "a diseased heart", which should read "the diseased heart" because of the disclosure of "a diseased heart" in line 3 of the claim. Claim 18 has been amended in accordance with the suggestion of the Examiner. Applicant therefore respectfully requests that this objection be withdrawn.

Rejection Under 35 U.S.C. § 102

Claims 18 and 32-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Alferness (U.S. Patent No. 5,702,343). Applicant notes as a preliminary matter that Alferness '343 is not prior art under 35 U.S.C. § 102(b). The effective filing date of this application is July 13, 1998, the filing date of the earliest application in the line of continuations (i.e. the filing date of application serial number 09/114,510, now U.S. Patent No. 6,123,662). In order for Alferness '343 to be prior art under 35 U.S.C. § 102(b), it should have issued before July 13, 1997, one year prior to the effective filing date of the application. Alferness '343 was issued on December 30, 1997, and is therefore not prior art under 35 U.S.C. § 102(b), but is instead prior art under 35 U.S.C. § 102(e).

Based on the above, the Applicant will address the rejection as if it were a rejection of claims 18 and 32-35 under 35 U.S.C. § 102(e). Claim 18 has been amended to add the step of "passing an electrical current to and from the heart". Applicant notes

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that the Examiner states that "even though Alferness '343 fails to explicitly disclose the ability to apply trans-chest defibrillation when the jacket is in place...". Therefore, based on the Examiner's own assertion, Alferness '343 does not anticipate amended claim 18.

Applicant also notes that Alferness '343 is not a proper basis for an obviousness rejection because Alferness '343 is not properly considered prior art under 35 U.S.C. § 103. According to 35 U.S.C. § 103(c) and MPEP § 706.02(k), subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person".

Applicant respectfully asserts that the subject matter of Alferness ('343) was, at the time of the invention of the subject matter of the instant application, owned by the same entity or subject to an assignment thereof to the same entity. Therefore, Alferness ('343) is not prior art under 35 U.S.C. § 103.

Based on the amendment to claim 18, and the comments offered above, Applicant respectfully requests that the rejection of claims 18 and 32-35 be withdrawn.

Although not raised with respect to the pending claims, Applicant notes that the disclosure of Alferness '343 was apparently considered an enabling reference for the element "selecting a device of electrical permeability sufficient to apply trans-chest defibrillation of the heart". If the amount of disclosure provided by Alferness '343 regarding electrical permeability and trans-chest defibrillation enables it as prior art for that element, then amended claim 18 cannot be said to be non-enabled for "passing an electrical current to and from the heart" because it provides much more disclosure regarding that claimed element.

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Conclusion

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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